

U.S. Pat. App. Ser. No. 10/565,180
Attorney Docket No. 10191/4029
Reply to Office Action of March 3, 2009

REMARKS

Claims 8, 9, 11 to 13, 15 to 17, and 19 to 21 are pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4) of the Office Action, Applicants thank the Examiner for considering the previously cited references JP 05-310119 and DE 33 03 455. Further, while a copy of the foreign references DE 197 32 924 and EP 1 066 181 should have been provided by the International Searching Authority, to facilitate matters, a copy of these foreign references DE 197 32 924 and EP 1 066 181 (cited in the International Search Report (and previously disclosed)) accompanies this response. In accordance with Office procedure, any translation requirement is satisfied by the International Search Report summary of the reference. It is respectfully requested that these previously disclosed foreign references be considered and made of record.

With respect to paragraphs six (6) and seven (7) of the Office Action, claims 9, 15 to 17, and 19 to 21 were rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

While the rejections may not be agreed with, to facilitate matters, claims 9, 15, and 19 have been rewritten to better clarify the claimed subject matter. It is respectfully submitted that the claims, as presented, now better comply with the definiteness requirement of the second paragraph of 35 U.S.C. § 112, and it is therefore respectfully requested that the rejections be withdrawn.

In view of the above, it is respectfully submitted that the presently pending claims comply with the second paragraph of § 112 since a person having ordinary skill in the art would understand what is claimed when the claim is read in view of the specification. See Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 27 U.S.P.Q.2d 123 (Fed. Cir. 1993). In this regard, it is also noted that terms in a claim are to be understood in view of the specification. (See In re Weiss, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); In re Okuzawa, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification”; Board reversed; emphasis in original) (citing In re Royka, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum” and “their terms still

have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)).

Approval and entry are therefore respectfully requested, as is withdrawal of the indefiniteness rejections.

With respect to paragraph ten (10) of the Office Action, claims 8, 9, 11 to 13, 15 to 17, and 19 to 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Salecker et al (GB 2 317 660).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it should also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to

combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

While the rejections may not be agreed with, to facilitate matters, claim 8 has been rewritten to provide the features of “*checking, in the event of a starting command, as to whether the vehicle is stationary, and if the vehicle is not stationary, authorizing a starting of the engine without a brake intervention.*” Support for the amendments may be found in the Substitute Specification, (e.g., at page 3, lines 28 to 31; and page 4, lines 3 to 9).

The Office Action admits that “Salecker et al. does not disclose ‘making a check as to whether the vehicle is stationary.’” As to Salecker, it does not disclose or suggest the feature of “*a control unit* checking whether the vehicle is stationary, as provided for in the context of claim 8, as presented. In this regard, the Substitute Specification at page 3, lines 8 to 18 describes a control unit 30 for checking that does not use a human operator. Therefore, Salecker does not disclose or suggest the feature “*checking, in the event of a starting command, as to whether the vehicle is stationary,* as provided for in the context of claim 8, as presented.

Further, there is no motivation or suggestion to modify Salecker to include the feature of checking as to whether the vehicle is stationary, since Salecker repeatedly and consistently requires that the vehicle be stationary by applying a vehicle brake prior to granting a starter release. (See Salecker et al., page 10, lines 1 to 2; see also Salecker et al., page 3, lines 7 to 10, and 31 to 33; page 4, lines 7 to 11; page 5, lines 24 to 28; page 7, line 34 to page 8, line 3; and page 8, lines 18 to 21.) Accordingly, because the vehicle of Salecker is required to be stationary prior to starting, “*there is no need for a control unit to check whether the vehicle is stationary.*” Therefore, there is no motivation or suggestion to modify Salecker to include the feature of “*checking, in the event of a starting command, as to whether the vehicle is stationary,* as provided for in the context of claim 8, as presented.

In addition, Salecker does not disclose nor suggest the feature of “*authorizing a starting of the engine without a brake intervention.*” As explained above, Salecker specifically requires that the vehicle is stationary by applying vehicle brakes prior to starting. Accordingly, Salecker does not disclose authorizing a starting without a brake intervention if the vehicle is not stationary, as provided for in the context of the presently claimed subject matter. Thus, Salecker does not disclose nor suggest the feature of “*authorizing a starting of the engine without a brake intervention if the vehicle is not stationary,* as provided for in the context of claim 8, as presented.

Further, the Office Action at page 5 inexplicably refers to a “push start” method to cure this deficiency of Salecker, but Salecker does not even mention any such “push start” method. Moreover, there is no motivation or suggestion to modify Salecker to include a “push start” method because, as explained above, Salecker requires that the vehicle be stationary prior to starting. Therefore, there is no motivation or suggestion to modify Salecker to include the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

Accordingly, it is respectfully submitted that claim 8, as presented, is allowable, as are its dependent claims 9, 11 to 13, 15 to 17, and 19 to 21. Withdrawal of the rejections is therefore respectfully requested.

With respect to paragraph eleven (11), claims 8 and 9 were rejected under 35 U.S.C. §103(a) as unpatentable over Balz et al. (WO 99/50112). (U.S. Patent No. 6,702,405 is a U.S. National Stage entry of International Patent Application Publication WO 99/50112.)

The Office Action admits (at page 7) that “Balz et al. does not distinctly disclose ‘making a check as to whether the vehicle is stationary.’” As explained above as to Balz, it does not disclose the feature of checking whether the vehicle is stationary, as provided for in the context of claim 8, as presented. In this regard, the Substitute Specification at page 3, lines 8 to 18 describes a control unit 30 for checking that does not use a human operator. Therefore, Balz does not disclose nor suggest the feature of a control unit to check, in the event of a starting command, as to whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

Further, there is no motivation or suggestion to modify Balz to include the feature of checking whether the vehicle is stationary. In this regard, Balz repeatedly and consistently specifically requires that the vehicle be stationary (either parked or by application of a parking brake) prior to starting the vehicle. (See Balz, column 1, line 62 to column 2, line 14.) Accordingly, because the vehicle of Balz is required to be stationary prior to starting, there is no need to check whether the vehicle is stationary. Therefore, there is no motivation or suggestion to modify Balz to include the feature of checking, in the event of a starting command, whether the vehicle is stationary, as provided for in the context of claim 8, as presented.

In addition, Balz does not disclose nor suggest the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary. As explained above, Balz specifically requires that the vehicle be stationary by either being parked or by applying a parking brake prior to starting. Accordingly, Balz does not disclose the feature of authorizing a starting without a brake intervention if the vehicle is not stationary, and it therefore does not disclose nor suggest the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

Further, contrary to the Office Action's assertions as to a "push start" method, Balz does not even mention a "push start" method. Moreover, there is no motivation or suggestion to modify Balz to include a "push start" method because, as explained above, Balz requires that the vehicle be stationary prior to starting. Therefore, there is no motivation or suggestion to modify Balz to include the feature of authorizing a starting of the engine without a brake intervention if the vehicle is not stationary, as provided for in the context of claim 8, as presented.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, it is respectfully submitted that claim 8, as presented, is allowable, as is its dependent claim 9. Withdrawal of the rejections is therefore respectfully requested.

Accordingly, claims 8, 9, 11 to 13, 15 to 17, and 19 to 21 are allowable.

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CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable and it is respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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